

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte SEAN B. WEATHERILL and  
JAMES B.A. TRACY

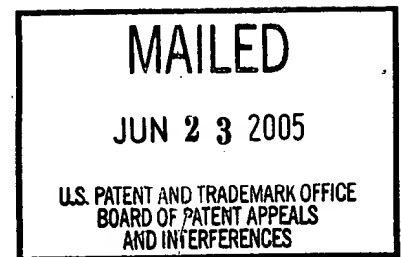
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Appeal No. 2005-1040  
Application No. 09/777,420

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DECISION ON PETITION

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On April 11, 2005, Appellants filed a paper styled "Petition for Oral Hearing" requesting waiver of the 37 CFR §1.194(b) requirement regarding a Request for Oral hearing. The Petition was further accompanied by a second Request for an Oral Hearing. The Petition shall be considered under 37 CFR §1.183 as a Request for Suspension of the Rules. The basis of the Petition was to present reasons why a Transmittal Sheet, containing a Request for an Oral Hearing therein, should be acceptable and, alternatively, why an Oral Hearing would be deemed as necessary in this appeal.

Counsel first states that because the Transmittal Sheet is separate from a Reply Brief, it would meet the separate paper requirement of 37 CFR §1.194(b). However, not only is the Transmittal Sheet intended to a summary of a number of papers, but moreover, 37 CFR § 41.52, which was in effect at the time both the Reply Brief with Transmittal Sheet was filed and

replaced former rule 37 CFR § 1.194(b), requires that a Request for an Oral Hearing to be in the form of a separate paper and not merely a paper separate from just a Reply Brief. See Form PTO/SB/32 regarding the proper format for a Requesting an Oral Hearing.

Counsel further states that:


An oral hearing is desired in this case because the claimed invention is very simple and relates partly to aesthetic aspects of this reel. Simple inventions are more subject to the much-discussed "hindsight trap," in which the very simplicity of an invention leads an examiner to use the applicant's own disclosure as a blueprint to defeat patentability. Moreover, inventions relating to aesthetic aspects are often not accorded much weight by the patent Office, despite the federal Circuit's contrary holdings. *See, e.g., In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). Accordingly, Appellants desire an oral hearing to fully address any concerns that the Board may have with respect to the invention's simplicity and aesthetic nature.

In the demonstrated need of an Oral Hearing, and in the interest of justice, the Petition is GRANTED, and

It is further ORDERED that this appeal is to be scheduled for an Oral Hearing in due course.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

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